



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|-------------------------------|-------------------------|------------------------------|-------------------------------|
| APPLICATION NO. 08/833,172 | FILING DATE 04/04/97 | FIRST NAMED INVENTOR ROBL | ATTORNEY DOCKET NO. HA580A |
|-------------------------------|-------------------------|------------------------------|-------------------------------|

BURTON RODNEY
BRISTOL-MYERS SQUIBB COMPANY
P O BOX 4000
PRINCETON NJ 08543-4000

HM12/0329

| |
|----------------------|
| EXAMINER BERCH, M |
|----------------------|

| | |
|------------------|--------------------|
| ART UNIT 1624 | PAPER NUMBER 13 |
|------------------|--------------------|

DATE MAILED: 03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 08/833,172
Filing Date: April 4, 1997
Appellant(s): Jeffrey A. Robl

Burton Rodney
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed June 14, 1999.

(1) *Real Party in Interest*

The brief does not contain a statement identifying the Real Party in Interest.

Therefore, it is presumed that the party named in the caption of the brief is the Real Party in Interest, i.e., the owner at the time the brief was filed. The Board, however, may exercise its discretion to require an explicit statement as to the Real Party in Interest.

Art Unit: 1624

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. Both amendments after final have been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: There is a third issue as well, noted below as item 1.

(7) *Grouping of Claims*

The rejection of claims 1, 6, 7, and 12-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Art Unit: 1624

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1, 6, 7 and 12-14 appears on pages 10-12 of the Appendix to the appellant's brief. The minor errors are as follows: In Claim 1, last line of definition of R1, there is a left parenthesis which is not actually in claim 1. Note issue 1 below.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 6, 7, and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Issue 1

There is a missing left parenthesis in claim 1, at the end of the definition for R⁶. The status of this is peculiar. It was raised in the Final Rejection. In the response after final, Paper 8 of 4-20-99, other things were fixed, but this error was repeated (see paper 8, page 2, 7th from last line). However, in the Appeal Brief, the issue is not argued, and the copy of the claims in the Appendix shows the missing parenthesis put in. But no amendment was ever made on this. Appellants appear to be under the misimpression that this has been fixed.

Issue 2

Art Unit: 1624

The terms "cycloheteroalkyl" is indefinite. It has no standard meaning, and is internally inconsistent. A cycloalkyl cannot have a heteroatom in the ring, because it would then no longer be a cycloalkyl. It could have a heteroatom as a substituent however. Or it could mean an alkyl substituted by a cycle with a heteroatom in it, i.e. (heterocyclo)-alkyl. If the term had been defined in the specification, appellants would have no problem, since their intention would be clear, but it is not. In the Appeal Brief, appellants state that it is "a saturated ring which includes at least one heteroatom." However, there is no evidence that this particular definition is what was originally intended. In an effort to establish that the term has a standard meaning, appellants have submitted numerous references. It should be noted that every single one is from Squibb. This tends to show that the term does not have a generally accepted meaning, but instead is a term used only by Squibb. Two of the references (Parker 5,488,068 and Biller 5,332,728) provide no definition. Of the others, not a single one provides a definition anywhere near as broad as is presently asserted. Misra 5,290,799 defines the term in column 3 of the specification as being limited to rings having 1 or 2 heteroatoms, with a ring size of 5-7 members, and which is bound via a ring carbon beta or gamma to the heteroatom. This is a much narrower definition than applicants propose, in ring size, number of heteroatoms, and place of bonding. The same appears in the other Misra reference. A similar but slightly broader definition comes from Kim, 5,561,146, which also requires that the ring be 5-7 members, and have only 1-2 heteroatoms, but places no limits on where the bonding is from. This definition is also seen in the Lawrence and Magnin references.

Art Unit: 1624

Accordingly, it is clear that the term does not have a conventional meaning in the art, and no reference submitted by applicants uses the definition which applicants now assert.

Issue 3

The definition of R is unclear. R appears in the structural formula attached via a single bond to a carbon which also has attached to it a - C(O)A group on the right, the HC(O)N(OR')C_x- group on the left, and a hydrogen. The first part of the definition, which sets forth R as H, alkyl, etc., is not a problem. But then it gives a second alternative: "R can be joined together with the carbon to which it is attached to form a 3 to 7 membered ring which may optionally be fused to a benzene ring." This makes no sense at all. A monovalent group cannot form a ring with that Carbon. One cannot obtain a ring with just one valence. Appellants respond that "R must be a bivalent group. This is inherent in the definition of R." (emphasis in the Appeal Brief). But this argument contradicts the structural formula which clearly shows that R is monovalent. It has one bond to the carbon. The carbon already has four bonds. If appellants had drawn two R groups attached to the carbon, then of course the two monovalent groups could be combined to form a single divalent group to obtain the ring. But the formula doesn't have two R groups, it just has one, and hence this part of the definition makes no sense. There is an additional problem: What is the nature of the 3-7 membered ring? The claim says nothing. The remarks state "the rings formed would have to be a carbocyclic single or monocyclic ring." That sentence is unclear. It is not clear whether the sentence is saying that there are two possible types of rings, the type before the "or" and

Art Unit: 1624


the type after the "or", or whether the sentence is saying just one type of ring, which is described in two different ways. Further, applicants appear to be arguing that the ring must be carbocyclic because it is made from the "alkyl" or "alkenyl" choices (Appeal Brief, page 8, 8th and 7th from last line.) But the claim makes no such requirement. The second alternative for R doesn't say that it is made from a piece of the first alternative for R. It is just a brand new alternative. Appellants, in an attempt to make the claim seem definite, are reading into the claim something that isn't there. The claim language clearly does not reflect appellants' intention and hence is indefinite.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Mark L. Berch
March 24, 2000



JOHN KIGHT
SUPERVISORY PATENT EXAMINER
GROUP 1600

John Kight III, Conferee



Mukund Shah, SPE

Burton Rodney
Bristol Myers Squibb Company
PO Box 4000
Princeton NJ 08543-4000

MUKUND J. SHAH
SUPERVISORY PATENT EXAMINER
GROUP 1600